

REMARKS

I. STATUS OF THE CLAIMS

Without prejudice or disclaimer, Claims 1 and 15 have been amended to restate the subject matter excluded from Z when X is O, R2 is O, and n is 0. Applicants maintains that no new matter has been added herein. Claims 1-9, 11-15, and 17-34 are pending with entry of this amendment. Applicants respectfully acknowledge the Office's indication that the previous anticipation rejections over Bekele have been withdrawn. See Office Action at 4.

II. INTERVIEW SUMMARY

Applicants thank Examiner Channavajjala for the courtesy extended in the interview with Applicants' representatives on October 5, 2009.

M.P.E.P. 713.04 provides eight items (A-H) that should be addressed in Applicants' submission of the substance of the interview. Applicants' submissions regarding each of those items are as follow:

- (A) The Exhibit shown at the interview is attached hereto as Exhibit 1.
- (B) All of the claims were generally discussed.
- (C) The interview included a discussion of Japanese Patent Application Publication 2001-158724 to Megumi et al. ("Megumi"), as set forth in Exhibit 1.
- (D) Amendments to Claim 1 were proposed as set forth in Exhibit 1.
- (E) Applicant's representatives discussed with Examiner Channavajjala the proposed amendments to claim 1, their support, and the non-obviousness of the claims, as proposed (and now as-amended), over Megumi.
- (F) All pertinent matters discussed at the interview are provided in Exhibit 1.

(G) No agreement was reached between Applicant's representatives and Examiner Channavajjala. Applicant will await Examiner Channavajjala's next action on the merits.

(H) This interview was in person with Deborah M. Herzfeld, with Wen Li's participation via telephone, so this item does not apply.

Examiner Channavajjala provided Applicants' representatives with an Examiner's Interview Summary on October 5, 2009.

III. REJECTION UNDER 35 U.S.C. § 112

A. First Paragraph

Claims 1-9, 11-15, and 17-34 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement." Office Action at 2-3. Specifically, the Office alleges that the previous amendments to claims 1 and 15, which exclude more compounds, are not supported by the specification, on the ground that "[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." Applicants respectfully disagree.

Solely to advance prosecution of this application, and without in any way conceding to the propriety of the rejection, Applicants have amended claims 1 and 15 to delete the proviso language in question. Applicants have further amended claims 1 and 15 to delete the element "C₁ to C₁₀ alkoxy", and to add the following new limitation:

wherein, if X is O, R₂ is O, and n is 0, then Z is not.... CH₂-CH(R")
wherein R" is a C₁-C₂₈ alkyl interrupted by at least one heteroatom, and optionally substituted by a hydroxy at the terminal carbon.

M.P.E.P. § 2173.05(i) indicates that "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of

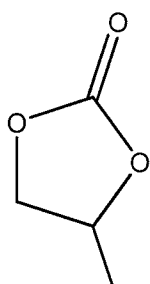
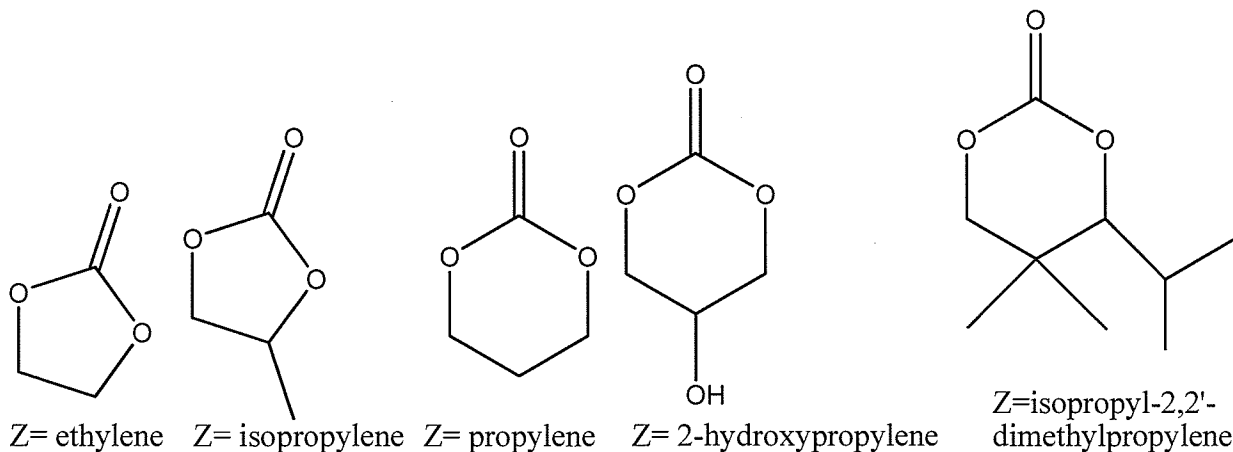
description support.” (citing *Ex parte Parks*, 30 USP2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)). Further, Applicants maintain that the newly added limitation is adequately described. First, paragraph [0025] of the published application, US 2004/0156800, states that “Z is chosen from divalent or branched C₂ to C₃₀ alkylene radicals . . . ” thus, Z can be CH₂-CH(R’), a formula which is recited in paragraph [0039] of the published application though with different range of R’. Also, given that Z is chosen from divalent linear or branched C₂ to C₃₀ alkylene radicals” as discussed above, it is immediately envisaged that R’ can be a C₁-C₂₈ alkyl radical. In addition, the elements “interrupted by at least one heteroatom” and “substituted by a hydroxyl” are all positively described in paragraph [0025] of the published application, and thus can be excluded as currently written. Accordingly, Applicants assert that they are simply claiming less than the full scope of the disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. See, e.g., *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977).

For the foregoing reasons, Applicants respectfully request that this rejection be withdrawn.

B. Second Paragraph

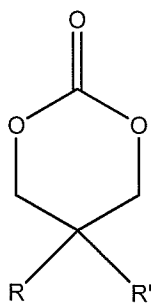
The Office maintains the rejection of claim 13 under 35 U.S.C. § 112, second paragraph as allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Office Action at 3-4. Specifically, the Examiner alleges that the compound V recited in Claim 13 contradicts the proviso recited in Claim 1. Applicants respectfully disagree and traverse.

The proviso compounds of claim 1, as amended, can be represented as follows:



R'', which is a C₁-C₂₈ alkyl interrupted by at least one heteroatom, and optionally substituted by a hydroxy at the terminal carbon.

In contrast, compound V of claim 13, as a positively recited compound, can be represented as the following structure:



R, and R' are C₁₋₄ alkyl

As such, none of the excluded compounds is identical to the compound V of claim 13. Accordingly, there is no alleged conflict between compound V of claim 13 and any proviso compound as recited in claim 1. Accordingly, this rejection is improper and should be withdrawn.

IV. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-9, 11-15, and 17-34 are rejected under 35 U.S.C. § 103(a) as allegedly “being unpatentable over” Japanese Patent Application Publication 2001-158724 to Megumi et al. (Megumi) for reasons set forth at pages 4-7 of the Office Action. Applicants respectively disagree and traverse. However, by this Amendment, Applicants have amended independent claims 1 and 15, which are the only independent claims included in this rejection. To the extent, however, that the Office may consider rejecting amended independent claims 1 and 15 based on Megumi, Applicants respectfully submit that Megumi, taken as a whole, fails to establish a prima facie case of obviousness with respect to the subject matter recited in amended independent claims 1 and 15, for the reasons below.

With respect to obviousness, several basic factual inquiries must be made to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. Those factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Office to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of those inquiries. *See Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. (BNA) at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d (BNA) 1385, 1388 (2007). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves

would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphasis in original, citations omitted). The mere fact that a reference can be modified does not render the resultant modification obvious unless the results would have been predictable to one of ordinary skill in the art at the time the invention was made. See M.P.E.P. § 2143.01(III and IV).

Applicants note the current claims, as amended, do not encompass any of the compounds described by Megumi generally or specifically. Moreover, there is no teaching within Megumi that would have directed one of skill in the art, at the time the invention was made, to arrive at the present claims. Thus, Megumi neither teaches nor suggests the use of cyclic carbonates within the scope of the present claims. Accordingly Applicants respectfully request the rejections be withdrawn.

V. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

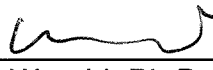
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (650) 849-6649.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 16, 2009

By: 
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